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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,864	04/13/2004	Hiroshi Ichikawa	64903-024	2673

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MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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KUMAR, KALYANAVENKA K

ART UNIT	PAPER NUMBER
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3653

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/822,864

Applicant(s)

ICHIKAWA ET AL.

Examiner

Kalyan Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4-13-2004.

- 4) ☐ Interview Summary (PTO-413).  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This is a first action on the merits of application 10/822864.

### ***Claim Objections***

Claim 17 is objected to because of the following informalities: Line 5-6 recites "sad banknote discrimination module". "Sad" should be changed to "said". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "another transaction process" without stating a first "transaction process."

Claim 13 recites the limitation "said multiple banknote storage boxes" in line 4-5. There is insufficient antecedent basis for this limitation in the claim. Multiple banknote storage boxes were not claimed beforehand.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-20 is rejected under 35 U.S.C. 102(b) as being anticipated by **Jones et al (USP 6,128,402)**. Regarding claim 1, 9-12, and 14-19, Jones discloses a banknote handling system comprising a money in-out slot (1), a conveyance module (16), multiple banknote discrimination modules (8), a banknote storage box (9), a collection box (col. 8, lines 49-51), and a control unit (34) that controls a management module (30) and updates the source data that includes a transaction record ID and transactor information comprising an account number and an employee number (10b).

Regarding claim 2 and 3, Jones discloses a temporary storage (11l), and a deposit cancellation process (11d, 11h, 11p).

Regarding claim 13, Jones discloses a banknote-sorting module (col. 9, lines 19-21).

Regarding claim 20, Jones discloses a step that obtains transactor information (10b), a step for banknote discrimination (11b), a step that stores a genuine banknote in the banknote storage box (10a), a step that manages mapping of the transactor information and the banknote discrimination (10i), a step that feeds out stored banknotes for banknote discrimination (16), a step that collects banknotes that are

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determined to be counterfeit (11f), a step that updates the mapping to said banknote storage box (10i).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Hirose (USP 4,554,444). Regarding claim 4, Jones discloses all the limitations of claim 1 and a money-out process. Jones does not disclose a money-out process that feeds banknotes from the banknote storage box. Hirose teaches a money-out process that feeds banknotes from the banknote storage box for the purpose of the deposited banknotes being used as banknotes for withdrawal (col. 2, lines 18-19). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system with a money-out process, as taught by Hirose, for the purpose of the deposited banknotes being used as banknotes for withdrawal.

Regarding claims 6-8, Jones discloses all the limitations of claim 1 and a detachable cassette (col. 8, lines 44-46). Jones does not disclose a banknote feed process that supplies banknotes to the banknote storage box from a place other than

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the money in-out slot. Hirose teaches a banknote feed process that supplies banknotes to the banknote storage box from a place other than the money in-out slot for the purpose of separately depositing notes of several denominations (col. 1, lines 63-66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system with a banknote feed process that supplies banknotes to the banknote storage box from a place other than the money in-out slot, as taught by Hirose, for the purpose of separately depositing notes of several denominations.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of **Guibord et al (USP 4,340,150)**. Regarding claim 5, Jones discloses all the limitations of claim 1. Jones does not disclose a left-money collection process that stores or collects a banknote. Guibord teaches a left-money collection process that stores or collects a banknote for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected (col. 1, lines 64-66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system with a left-money collection process that stores or collects a banknote, as taught by Guibord, for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan Kumar whose telephone number is 571-272-8102. The examiner can normally be reached on Mon-Fri 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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